

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of

BARIK, Rajkishore

Serial No.: 09/772,244

Group Art Unit: 3622

Filed: January 29, 2001

Examiner: Carlson, Jeffrey

For: **ELECTRONIC COUPONS DECISION SUPPORT AND
RECOMMENDATION SYSTEM**

Honorable Commissioner of Patents
Alexandria, Virginia 22313-1450

APPELLANT'S BRIEF ON APPEAL

Sir:

Appellant respectfully appeals the Final Rejection of claims 1-2, 4-5, 7, 15-16, 18-19, 22-31, 33-35, 49-57, 59-62, 64, 66-67 and 69-70 in the Final Office Action dated January 14, 2010. Notice of Appeal was timely filed on March 8, 2010.

I. REAL PARTY OF INTEREST
[37 C.F.R. §41.37 (c)(1)(i)]

The real party of interest is INTERNATIONAL BUSINESS MACHINES, INC., assignee of 100% interest of the above-referenced patent application.

II. RELATED APPEALS AND INTERFERENCES
[37 C.F.R. §41.37 (c)(1)(ii)]

There are no other appeals or interferences known to Appellant, Appellant's legal representative or Assignee, which would directly affect or be directly affected by or have a bearing on the Board's decision on this appeal.

III. STATUS OF CLAIMS
[37 C.F.R. §41.37 (c)(1)(iii)]

Claims 1-2, 4-5, 7, 15-16, 18-19, 22-31, 33-35, 49-57, 59-62, 64, 66-67 and 69-70, all of the claims in the Application, are set forth fully in the attached Appendix.

Claims 3, 6, 8-14, 17, 20-21, 28-29, 32, 36-48, 55-56, 58, 63, 65, 68 and 71-73 are cancelled.

Claims 1-2, 4-5, 7, 15-16, 18-19, 22-27, 30-31, 33, 35, 49-54, 57, 59, 61-62 and 66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski, U.S. Pat. No. 6,932,270.

Claims 34, 60 and 64 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski, U.S. Pat. No. 6,932,270, further in view of Beach et al., U.S. Pat. App. Pub. No. US2002/10107738.

Claims 1-2, 4-5, 7, 15-16, 18-19, 22-31, 33, 35, 40-57, 59, 61-62 and 66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski, U.S. Pat. No. 6,932,270, further in view of Marmon, U.S. Pat. No. 4,446,528.

Claims 34, 60 and 64 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski, U.S. Pat. No. 6,932,270, further in view of Marmon U.S. Pat. No. 4,446,528 and Beach et al., U.S. Pat. App. Pub. No. US2002/10107738.

Claims 1-2, 4-5, 7, 15-16, 18-19, 22-31, 33, 35, 40-57, 59, 61-62 and 66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski, U.S. Pat. No. 6,932,270, further in view of Wilkman, U.S. Pat. App. Pub. No. 2002/0013728.

Claims 34, 60 and 64 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski, U.S. Pat. No. 6,932,270, further in view of Wilkman, U.S. Pat. App. Pub. No. 2002/0013728 and Beach et al., U.S. Pat. App. Pub. No. US2002/10107738.

Claims 1-2, 4-5, 7, 15-16, 18-19, 22-31, 33, 35, 40-57, 59, 61-62 and 66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski, U.S. Pat. No. 6,932,270, further in view of Wilkman, U.S. Pat. App. Pub. No. 2002/0013728 and Marmon, U.S. Pat. No. 4,446,528.

Claims 34, 60 and 64 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski, U.S. Pat. No. 6,932,270, further in view of Wilkman, U.S. Pat. App. Pub. No. 2002/0013728, Marmon U.S. Pat. No. 4,446,528 and Beach et al., U.S. Pat. App. Pub. No. US2002/10107738.

Appellant hereby appeals the rejection of claims 1-2, 4-5, 7, 15-16, 18-19, 22-31, 33-35, 49-57, 59-62, 64, 66-67 and 69-70.

IV. STATUS OF AMENDMENTS
[37 C.F.R. §41.37 (c)(1)(iv)]

An Non-Final Amendment under 37 C.F.R. § 1.111 was filed on October 6, 2009 in response to a Non-Final Office Action mailed on July 6, 2009. A second Non-Final Office Action was mailed on January 14, 2010 substantially identical to the Non-Final Office Action

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mailed on July 6, 2009. Therefore, the claims in the Appendix reflect the version of the -
claims in the Non-Final Amendment filed on October 6, 2009.

A Notice of Appeal was timely filed on March 8, 2010.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER
[37 C.F.R. §41.37 (c)(1)(v)]

The claimed invention of exemplary claim 1, (and similarly independent claims 15, 22, 49, 62), is directed to recommending to a user to use an additional e-coupon in relation to a purchase based on choosing one particular saved set of e-coupons.

Referring to the exemplary embodiments of the invention depicted in Figs. 1-14, the following refer to the subject matter defined in each claim involved in this appeal by referring to the specification by page and line number and to the reference numbers of the drawings.

Appellant notes, however, that the claims should not be construed as limited necessarily to the exemplary embodiments depicted in the drawings and described at the specified page and line numbers of the specification.

Claim 1. A computer-implemented method of making an optimized suggestion to a user regarding a combination of electronic coupons (e-coupons) for redemption by a retailer, said method comprising: (1) determining, by said computer, if a selection of e-coupons complies with redeeming conditions in relation to a purchase {**Fig. 1; element 100; para. [0062]**}; (2) checking said selection of e-coupons complying with said redeeming conditions {**Fig. 1; element 100; para. [0062]**}, (3) by said computer, to determine mutually exclusive e-coupons of said selection of e-coupons applicable within said purchase {**Fig. 1; element 110; para. [0062]**}, and (4) to determine if two or more non-mutually exclusive e-coupons of said selection of e-coupons can be used in combination within said purchase {**Fig. 1; element 100; para. [0068]**}; (5) defining optimization parameters by a user {**Fig. 4; element 422; para. [0078]**}; (6) performing an optimization process, by said computer, on said selection of e-coupons to maximize a discount amount, a number of loyalty points, and a number of free items {**Fig. 4; element 422; para. [0078]**}, (7) by checking said selection of e-coupons complying with said redeeming conditions and capable of being used in

combination within said purchase to determine if said selection of e-coupons satisfy said optimization parameters, said optimization process determining a most favorable combination of non-mutually exclusive e-coupons {**Fig. 1; element 100; para. [0068]**}; (8) before said user makes said purchase, outputting a suggestion to said user {**Fig. 4; element 400; para. [0078]**}, (9) by said computer, displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons, said most favorable combination of non-mutually exclusive e-coupons comprising only said selection of e-coupons complying with said redeeming conditions and capable of being used in combination within said purchase {**Fig. 1; element 100; para. [0068]**}; (10) saving said displayed most favorable combination of non-mutually exclusive e-coupons determined to comply with said redeeming conditions and capable of being used in combination within the same purchase and choosing another subset of said e-coupons {**Fig. 1; element 100; para. [0068]**}; (11) choosing one of saved sets of e-coupons based on comparing two or more of said saved sets of e-coupons {**Fig. 1; element 100; para. [0068]**}; and (12) recommending to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons {**Fig. 1; element 100; para. [0068]**}.

Claim 15. A computer program product having a computer readable medium having a computer program recorded therein for making an optimized suggestion to a user regarding a combination of electronic coupons (e-coupons) for redemption by a retailer, said computer program product performing a method comprising: (1) determining if a selection of e-coupons complies with redeeming conditions in relation to a purchase{**Fig. 1; element 100; para. [0062]**}; (2) checking said selection of e-coupons complying with said redeeming conditions {**Fig. 1; element 100; para. [0062]**}; (3) to determine mutually exclusive e-coupons of said selection of e-coupons applicable within said purchase {**Fig. 1; element 110;**

para. [0062]}, and (4) to determine if two or more non-mutually exclusive e-coupons of said selection of e-coupons can be used in combination within said purchase **{Fig. 1; element 100; para. [0068]}**; (5) defining optimization parameters by a user **{Fig. 4; element 422; para. [0078]}**; (6) performing an optimization process on said selection of e-coupons to maximize a discount amount, a number of loyalty points, and a number of free items **{Fig. 4; element 422; para. [0078]}**; (7) by checking said selection of e-coupons complying with said redeeming conditions and capable of being used in combination within said purchase to determine if said selection of e-coupons satisfy said optimization parameters, said optimization process determining a most favorable combination of non-mutually exclusive e-coupons**{Fig. 1; element 100; para. [0068]}**; (8) before said user makes said purchase, outputting a suggestion to said user **{Fig. 4; element 400; para. [0078]}**; (9) displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons, said most favorable combination of non-mutually exclusive e-coupons comprising only said selection of e-coupons complying with said redeeming conditions and capable of being used in combination within said purchase **{Fig. 1; element 100; para. [0068]}**; (10) saving said displayed most favorable combination of non-mutually exclusive e-coupons determined to comply with said redeeming conditions and capable of being used in combination within the same purchase and choosing another subset of said e-coupons **{Fig. 1; element 100; para. [0068]}**; (11) choosing one of saved sets of e-coupons based on comparing two or more of said saved sets of e-coupons **{Fig. 1; element 100; para. [0068]}**; and (12) recommending to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons.

Claim 22. A computer-implemented method for electronic coupon (e-coupon) decision support, said method comprising: (1) computing, by said computer, a set of

applicable e-coupons dependent upon a set of e-coupons of a user {**Fig. 1; element 100; para. [0062]**}; (2) determining, by said computer, if said computed set of e-coupons complies with one or more redeeming conditions {**Fig. 1; element 100; para. [0062]**}, (3) which of said set of e-coupons are mutually exclusive within a same purchase and which of said set of e-coupons are non-mutually exclusive to be used in combination within the same purchase {**Fig. 1; element 100; para. [0068]**}; (4) performing an optimization process, by said computer, on said selection of e-coupons to maximize a discount amount, a number of loyalty points, and a number of free items {**Fig. 4; element 422; para. [0078]**}, (5) by determining if said computed set of e-coupons determined to comply with said redeeming conditions and capable of being used in combination within the same purchase satisfy optimization parameters defined by said user, wherein said optimization parameters comprise at least one of a discount amount, loyalty points, a number of free items received, whether at least one particular e-coupon should be included, whether at least one particular e-coupon should not be included, expiration date, and a total number of e-coupons used, said optimization process determining a most favorable combination of non-mutually exclusive e-coupons {**Fig. 1; element 100; para. [0068]**}; (6) before said user makes said purchase, outputting a suggestion to said user, by said computer, displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons, said most favorable combination of non-mutually exclusive e-coupons comprising only said computed set of e-coupons determined to comply with said redeeming conditions and capable of being used in combination within the same purchase that satisfy said optimization parameters {**Fig. 4; element 400; para. [0078]**}; (7) saving said displayed, computed set of e-coupons determined to comply with said redeeming conditions and capable of being used in combination within the same purchase and choosing another subset of said e-

coupons {**Fig. 1; element 100; para. [0068]**}; (8) comparing by a user two or more saved sets of e-coupons and choosing one of saved sets of e-coupons {**Fig. 1; element 100; para. [0068]**}; and (9) recommending to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons {**Fig. 1; element 100; para. [0068]**}.

Claim 49. A computer program product having a computer readable medium having a computer program recorded therein for electronic coupon (e-coupon) decision support, said computer program product including: (1) computing a set of applicable e-coupons dependent upon a set of e-coupons of a user {**Fig. 1; element 100; para. [0062]**}; (2) determining if said computed set of e-coupons complies with one or more redeeming conditions {**Fig. 1; element 100; para. [0062]**}, (3) which of said set of e-coupons are mutually exclusive within a same purchase and which of said set of e-coupons are non-mutually exclusive to be used in combination within the same purchase {**Fig. 1; element 100; para. [0068]**}; (4) performing an optimization process on said selection of e-coupons to maximize a discount amount, a number of loyalty points, and a number of free items {**Fig. 4; element 422; para. [0078]**}, (5) by determining if said computed set of e-coupons determined to comply with said redeeming conditions and capable of being used in combination within the same purchase satisfy optimization parameters defined by said user, wherein said optimization parameters comprise at least one of a discount amount, loyalty points, a number of free items received, whether at least one particular e-coupon should be included, whether at least one particular e-coupon should not be included, expiration date, and a total number of e-coupons used, said optimization process determining a most favorable combination of non-mutually exclusive e-coupons{**Fig. 1; element 100; para. [0068]**}; (6) before said user makes a purchase, outputting a suggestion to said user

displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons, said most favorable combination of non-mutually exclusive e-coupons comprising only said computed set of e-coupons determined to comply with said redeeming conditions and capable of being used in combination within the same purchase that satisfy said optimization parameters {**Fig. 4; element 400; para. [0078]**};
(7) saving said displayed, computed set of e-coupons determined to comply with said redeeming conditions and capable of being used in combination within the same purchase and choosing another subset of said e-coupons {**Fig. 1; element 100; para. [0068]**} ; (8) comparing by a user two or more saved sets of e-coupons; (9) choosing one of said saved sets of e-coupons **Fig. 1; element 100; para. [0068]**; and (10) recommending to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons **Fig. 1; element 100; para. [0068]**.

Claim 62. An electronic coupon (e-coupon) decision support system for making an optimized suggestion to a user regarding a combination of electronic coupons (e-coupons) for redemption by a retailer, said system including: a hardware module adapted to: (1) compute a set of applicable e-coupons dependent upon a set of e-coupons of a user{**Fig. 1; element 100; para. [0062]**} ; (2) determine if said computed set of e-coupons complies with one or more redeeming conditions {**Fig. 1; element 100; para. [0062]**}, (3) which of said set of e-coupons are mutually exclusive within a same purchase and which of said set of e-coupons are non-mutually exclusive to be used in combination within the same purchase {**Fig. 1; element 100; para. [0068]**} ; and (4) display only said computed set of e-coupons determined to comply with said redeeming conditions and capable of being used in combination within the same purchase {**Fig. 1; element 100; para. [0068]**} ; (5) an optimization engine adapted to perform an optimization process on said selection of e-

coupons to maximize a discount amount, a number of loyalty points, and a number of free items, by determining a subset of e-coupons from said computed set of e-coupons determined to comply with said redeeming conditions and capable of being used in combination within the same purchase, to determine a most favorable combination of non-mutually exclusive e-coupons {**Fig. 1; element 100; para. [0068]**}; and (6) a user interface adapted to output a suggestion to said user displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons, said most favorable combination of non-mutually exclusive e-coupons before said user makes said purchase {**Fig. 1; element 100; para. [0068]**}; (7) a storage device adapted to save said displayed most favorable combination of non-mutually exclusive e-coupons determined to comply with said redeeming conditions and capable of being used in combination within the same purchase and choosing another subset of said e-coupons, wherein one of saved sets of e-coupons is chosen based on comparing two or more of said saved sets of e-coupons {**Fig. 1; element 100; para. [0068]**}; (8) wherein said user interface communicates a recommendation to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons {**Fig. 1; element 100; para. [0068]**}.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL
[37 C.F.R. §41.37 (c)(1)(vi)]

Ground 1: Appellant respectfully appeals the rejections of claims 1-2, 4-5, 7, 15-16, 18-19, 22-27, 30-31, 33, 35, 49-54, 57, 59, 61-62 and 66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski, U.S. Pat. No. 6,932,270, which is the first issue in this Appeal.

Ground 2: Appellant respectfully appeals the rejections of claims 1-2, 4-5, 7, 15-16, 18-19, 22-31, 33, 35, 40-57, 59, 61-62 and 66 stand rejected under 35 U.S.C. §103(a) as

being unpatentable over Fajkowski, U.S. Pat. No. 6,932,270, further in view of Marmon, U.S. Pat. No. 4,446,528, which is the next issue in this Appeal.

Ground 3: Appellant respectfully appeals the rejections of claims 1-2, 4-5, 7, 15-16, 18-19, 22-31, 33, 35, 40-57, 59, 61-62 and 66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski, U.S. Pat. No. 6,932,270, further in view of Wilkman, U.S. Pat. App. Pub. No. 2002/0013728, which is the next issue in this Appeal.

Ground 4: Claims 1-2, 4-5, 7, 15-16, 18-19, 22-31, 33, 35, 40-57, 59, 61-62 and 66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski, U.S. Pat. No. 6,932,270, further in view of Wilkman, U.S. Pat. App. Pub. No. 2002/0013728, and Marmon, U.S. Pat. No. 4,446,528, which is the next issue in this Appeal.

VII. ARGUMENT

[37 C.F.R. §41.37 (c)(1)(vii)]

A. THE EXAMINER'S POSITION

In the Final Office Action mailed January 14, 2010, the Examiner rejected claims 1-2, 4-5, 7, 15-16, 18-19, 22-27, 30-31, 33, 35, 49-54, 57, 59, 61-62 and 66 under 35 U.S.C. §103(a) as being unpatentable over Fajkowski, U.S. Pat. No. 6,932,270 alone.

The Examiner beginning on page 2 of the Non-Final Office Action alleged that,

Regarding claims 1-2, 15-16, 27, 30, 54, 57, Fajkowski teaches systems and methods for storing electronic coupons, associating them with customers, presenting them at a retail POS and redeeming them. A user is provided with a card which provides a userID [4:6-81]. The card is used to associate selected coupons from a plurality of available coupons from different sources (by scanning paper coupons, by selecting coupons at a kiosk or by downloading coupons from the Internet) with the user's account in a database [3:63-65, 6:1-5,6:22-25]. When the card is presented at the POS along with scanned products to be purchased (i.e. before the purchase is completed by way of accepting payment - and therefore, "before purchase"), the POS system determines what coupons of the user's collection of selected coupons are redeemable given the user's scanned products; the system displays these coupons on the display [16:18-31, 17:31-33,4:25-35]. Fajkowski teaches that the coupon eligibility parameters (product name, required size, quantity or combination of items

required, expiration) may be stored on the card in order to determine applicable coupons at the POS against the parameter requirements [10:17-26]. Applicant admits that mutual exclusivity is a restrictive, eligibility coupon parameter often used [spec page 1 lines 21- 22] and that certain coupons also may provide benefits of monetary discount, loyalty points and freebies [spec pg 2 lines 14-19]. It would have been obvious for one of ordinary skill in the art at the time of the invention to have stored and analyzed other well known coupon restriction rules such as whether other coupons can be used in combination with a coupon. Doing so would enable the system to process and accurately display a wide variety of eligible coupons, including those with exclusivity rules and those without. Examiner will now address the limitations associated with checking if eligible coupons also meet optimization parameters. Applicant has admitted that customers frequently have a collection of eligible coupons from which to choose, leaving the consumer with the task of determining which subset of eligible coupons will provide optimum benefit (i.e. optimum price reduction, optimum loyalty points, optimum freebies). It has been done manually, but it is admittedly difficult in certain situations [spec pg 2 lines 11 -19]. Historically, checkout clerks inherently were required to possess the ability to determine coupon eligibility, else fraudulent coupon redemption would be possible. One of ordinary skill would consider it to be a matter of good customer service for a checkout clerk to assist a customer regarding which coupons could be used (i.e. eligibility) as well which subset of coupons would most benefit the customer for example helping a customer who asks "which coupon(s) would' save the most money?" and/or "which of these coupons should I use quickly before they expire" There should be no doubt that consumers frequently use coupons in order to get the best savings. It would have been obvious to one of ordinary skill at the time of the invention to have provided assistance to customers faced with navigating the recognized (albeit in some cases difficult or confusing) coupon rules and options imposed by the retailer. Fajkowski's system accomplishes the automated eligibility determination in the manner of an Expert System (a computer system programmed to replace a human clerk having the knowledge to determine eligibility for the universe of participating coupons and their restrictions/parameters). Fajkowski's system is also quite intelligent in that it can recommend an additional purchase when a consumer possesses a valuable coupon, but has not fully met the purchasing qualifications (perhaps the user chose the wrong size product) [19:38-43]. This is another example of an Expert System capability. Fajkowski's system has been argued to lack presentation to the consumer of a subset of all eligible coupons according to price optimization, yet it would have been obvious to one of ordinary skill at the time of the invention to have provided this desired but heretofore manual capability in an automated manner. See Automating a manual activity -MPEP 2144.04(111). In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). In the same manner as outlined in rationale F of KSR, it would have been obvious to one of ordinary skill at the time of the invention to have updated the known invention of Fajkowski with modern automated improvements in order to gain the commonly understood benefits of such adaptation. All this would be accomplished with no unpredictable results.

As stated in Leapfrog, "applying modern electronics to older mechanical devices has been commonplace in recent years." Leapfrog Enterprises, Inc. v. Fisher-Price, 485 F.3d 1157, 82 USPQ2d 1687 (Fed. Cir. 2007). Regarding the saved

coupons, the choosing among them and recommending based on the saved coupons, Fajkowski teaches that the user may save shopping lists with specified coupons for the products on the list to be used on future shopping trips [13:14- 41]. Fajkowski also teaches the idea of issuing a rain check for a coupon item the user wishes to purchase, but where the item is currently unavailable. The system will save such a list of rain-checked product(s) for later use. In either case, future use of the saved lists are taken to meet the broad "comparing" by a user. Further, the art describes the capability to save any number of coupons which enables saving combinations of coupons. It would have been obvious to one of ordinary skill at the time of the invention to have recalled saved coupons or a combination of saved coupons for later consideration (i.e. for future comparison). It would have been obvious to one of ordinary skill at the time of the invention for the system's coupon(s) recommendations to have included coupons that had been "saved". Further still, Fajkowski's also teaches that the system can recommend an additional purchase when a consumer possesses a valuable coupon, but has not fully met the purchasing qualifications (perhaps the user chose the wrong size product) [19:38-43]. It would have been obvious to one of ordinary skill at the time of the invention to have recommended the use of saved coupon where the user is close to an optimized coupon eligibility, but needs to make slight changes to his products for purchase. It would have been obvious to one of ordinary skill at the time of the invention to have recommended this additional coupon even if this is a coupon that had been previously saved.

In the Final Office Action mailed January 14, 2010, the Examiner rejected claims 1-2, 4-5, 7, 15-16, 18-19, 22-31, 33, 35, 40-57, 59, 61-62 and 66 under 35 U.S.C. §103(a) as being unpatentable over Fajkowski, U.S. Pat. No. 6,932,270, further in view of Marmon, U.S. Pat. No. 4,446,528.

The Examiner beginning on page 9 of the Non-Final Office Action alleged that,

Regarding claims 1-2, 15-16, 27, 30, 54, 57, Fajkowski teaches systems and methods for storing electronic coupons, associating them with customers, presenting them at a retail POS and redeeming them. A user is provided with a card which provides a, userID [4:6-8]. The card is used to associate selected coupons from a plurality of available coupons from 'different sources (by scanning paper coupons, by selecting coupons at a kiosk or by downloading coupons from the Internet) with the user's account in a database [3:63-65, 6:1-5, 6:22-25]. When the card is presented at the POS along with products to be purchased, the POS system determines what coupons of the user's collection of selected coupons are redeemable given the user's potential purchases; the system displays these coupons on the display [16:18-31, 17:31- 33,4:25-35]. Fajkowski teaches that the coupon eligibility parameters (product name, required size, quantity or combination of items required, expiration) may be stored on the card in order to determine applicable coupons at the POS [10:17-26]. Applicant admits that mutual exclusivity is a restrictive, eligibility coupon parameter often used [spec page 1 lines 21-22]. It would have been obvious for one of ordinary skill in the art at the time of the invention to have stored and analyzed other well

known coupon restriction rules such as whether other coupons can be used in combination with a coupon. Doing so would enable the system to process and accurately display a wide variety of eligible coupons, including those with exclusivity rules. Examiner will now address the limitations associated with checking if eligible coupons also meet optimization parameters. Applicant has admitted that customers frequently have a collection of eligible coupons from which to choose, leaving the consumer with the task of determining which subset of eligible coupons will provide optimum benefit (i.e. optimum price reduction, optimum loyalty points, optimum freebies). It has been done manually, but it is admittedly difficult in certain situations [spec pg 2 lines 11-19]. Historically checkout clerks inherently were required to possess the ability to determine coupon eligibility, else fraudulent coupon redemption would be possible. Marmon teaches that shopping can get quite complicated when pricing systems are combined with cents off coupons and retailers offer to double or triple coupons [col 1 lines 38-42]. Fajkowski provides a calculating tool for optimizing purchasing decisions affected by the complex pricing combinations that include coupons [col 1 lines 50-60]. Marmon notes that the consumer is confronted with many price-affecting choices related to coupons and that he usually is seeking low prices [col 2 lines 53-57]. Understanding the choice of optimum purchase requires an understanding of coupon procedures (i.e. rules) and unit pricing techniques [col 3 lines 20-22]. The calculations done by the system of Fajkowski consider the impact of the coupon and the optimum choice, i.e. lowest until price is indicated to the user [col 3 lines 51-53]. Fajkowski's system accomplishes the automated eligibility determination and it would have been obvious to one of ordinary skill at the time of the invention to have also provided automated coupon optimization assistance (i.e. indicating the best coupon(s) to use in order to best reduce the price given the subset of eligible coupons possessed) to customers faced with navigating the coupon rules and options imposed by the retailer. This would enable the customer to most benefit from his coupons, deliver the lowest prices as is generally desired as well as encourage purchasing of retailer products. Regarding the saved coupons, the choosing among them and recommending based on the saved coupons, Fajkowski teaches that the user may save shopping lists with specified coupons for the products on the list to be used on future shopping trips [13:14-41]. Fajkowski also teaches the idea of issuing a rain check for a coupon item the user wishes to purchase, but where the item is currently unavailable. The system will save such a list of rain-checked product(s) for later use. In either case, future use of the saved lists are taken to meet the broad "comparing" by a user. Further, the art describes the capability to save any number of coupons which enables saving combinations of coupons. It would have been obvious to one of ordinary skill at the time of the invention to have recalled saved coupons or a combination of saved coupons for later consideration (i.e. for future comparison). It would have been obvious to one of ordinary skill at the time of the invention for the system's coupon(s) recommendations to have included coupons that had been "saved". Further still, Fajkowski's also teaches that the system can recommend an additional purchase when a consumer possesses a valuable coupon, but has not fully met the purchasing qualifications (perhaps the user chose the wrong size product) [19:38-43]. It would have been obvious to one of ordinary skill at the time of the invention to have recommended the use of saved coupon where the user is close to an optimized coupon eligibility, but needs to make slight changes to his products for purchase. It would have been obvious to one of ordinary skill at the time of the

invention to have recommended this additional coupon even if this is a coupon that had been previously saved.

In the Final Office Action mailed January 14, 2010, the Examiner rejected claims 1-2, 4-5, 7, 15-16, 18-19, 22-31, 33, 35, 40-57, 59, 61-62 and 66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski, U.S. Pat. No. 6,932,270, further in view of Wilkman, U.S. Pat. App. Pub. No. 2002/0013728.

The Examiner beginning on page 14 of the Non-Final Office Action alleged that,

Regarding claims 1-2, 15-16, 27, 30, 54, 57, Fajkowski teaches systems and methods for storing electronic coupons, associating them with customers, presenting them at a retail POS and redeeming them. A user is provided with a card which provides a userID [4:6-8]. The card is used to associate selected coupons from a plurality of available coupons from different sources (by scanning paper coupons, by selecting coupons at a kiosk or by downloading coupons from the Internet) with the user's account in a database [3:63-65, 6:1-5, 6:22-25]. When the card is presented at the POS along with scanned products to be purchased (i.e. before the purchase is completed by way of accepting payment - and therefore, "before purchase"), the POS system determines what coupons of the user's collection of selected coupons are redeemable given the user's scanned products; the system displays these coupons on the display [16:18-31, 17:31-33, 4:25-35]. Fajkowski teaches that the coupon eligibility parameters (product name, required size, quantity or combination of items required, expiration) may be stored on the card in order to determine applicable coupons at the POS [10:17-26]. Applicant admits that mutual exclusivity is a restrictive, eligibility coupon parameter often used [spec page 1 lines 21-22] and that certain coupons also may provide benefits of monetary discount, loyalty points and freebies [spec pg 2 lines 14-19]. It would have been obvious for one of ordinary skill in the art at the time of the invention to have stored and analyzed other well known coupon restriction rules such as whether other coupons can be used in combination with a coupon. Doing so would enable the system to process and accurately display a wide variety of eligible coupons, including those with exclusivity rules. Examiner will now address the limitations associated with checking if eligible coupons also meet optimization parameters. Applicant has admitted that customers frequently have a collection of eligible coupons from which to choose, leaving the consumer with the task of determining which subset of eligible coupons will provide optimum benefit (i.e. optimum price reduction, optimum loyalty points, optimum freebies). It has been done manually, but it is admittedly difficult ('non trivial' in certain situations [spec pg 2 lines 11 -19]. Historically checkout clerks inherently were required to possess the ability to determine coupon eligibility, else fraudulent coupon redemption would be possible. One of ordinary skill would consider it to be a matter of good customer service for a checkout clerk to assist a customer regarding which coupons could be used (i.e. eligibility) as well which subset of coupons would most benefit the customer for example helping a customer who asks "which coupon(s) would save the most money?" and/or "which of these coupons should I use quickly before they

"expire" Fajkowski's system is also not without automation and is quite intelligent in that it can recommend an additional purchase when a consumer possesses a valuable coupon, but has not fully met the purchasing qualifications (perhaps the user chose the wrong size product) [19:38-43]. Wilkman also recognizes the variety of incentive offers available to purchasing consumers and he teaches the use of a computer-based optimization routine that takes the legwork out of manually analyzing the variety of eligible combinations and benefits (price, coupons, promotions, loyalty, etc.) in order to provide the best benefit for the consumer [abstract]. It would have been obvious to one of ordinary skill at the time of the invention to have provided systems and methods that provide assistance to customers faced with navigating the recognized (albeit in some cases difficult or confusing) coupon rules and options imposed by the incentive providers. Rather than take the time and energy to manually track all of the provided options, restrictions and benefits, it would have been obvious to one of ordinary skill at the time of the invention to have provided a computer system to optimize the 'non trivial' combination of coupon restrictions and benefits, so that the consumer need not be burdened with the research (although it is well accepted that in the past the research has been capably done manually). Regarding the saved coupons, the choosing among them and recommending based on the saved coupons, Fajkowski teaches that the user may save shopping lists with specified coupons for the products on the list to be used on future shopping trips [13:14-41]. Fajkowski also teaches the idea of issuing a rain check for a coupon item the user wishes to purchase, but where the item is currently unavailable. The system will save such a list of rainchecked product(s) for later use. In either case, future use of the saved lists are taken to meet the broad "comparing" by a user. Further, the art describes the capability to save any number of coupons which enables saving combinations of coupons. It would have been obvious to one of ordinary skill at the time of the invention to have recalled saved coupons or a combination of saved coupons for later consideration (i.e. for future comparison). It would have been obvious to one of ordinary skill at the time of the invention for the system's coupon(s) recommendations to have included coupons that had been "saved". Further still, Fajkowski's also teaches that the system can recommend an additional purchase when a consumer possesses a valuable coupon, but has not fully met the purchasing qualifications (perhaps the user chose the wrong size product) [19:38-43]. It would have been obvious to one of ordinary skill at the time of the invention to have recommended the use of saved coupon where the user is close to an optimized coupon eligibility, but needs to make slight changes to his products for purchase. It would have been obvious to one of ordinary skill at the time of the invention to have recommended this additional coupon even if this is a coupon that had been previously saved.

In the Final Office Action mailed January 14, 2010, the Examiner rejected claims 1-2,4-5,7,15-16,18-19,22-27,30-31,33,35,49-54,57, 59, 61, 62, 66, 67,69,70 under 35 U.S.C. 103(a) as being unpatentable over Fajkowski, U.S. Pat. No. 6,932,270, further in view of Wilkman, U.S. Pat. App. Pub. No. 2002/0013728, and Marmon, U.S. Pat. No. 4,446,528.

The Examiner beginning on page 20 of the Non-Final Office Action alleged that,

Regarding claims 1-2, 15-16, 27, 30, 54, 57, Marmon teaches that shopping can get quite complicated when pricing systems are combined with cents off coupons and retailers offer to double or triple coupons [col 1 lines 38-42]. Fajkowski provides a calculating tool for optimizing purchasing decisions affected by the complex pricing combinations that include coupons [col 1 lines 50-60]. Marmon notes that the consumer is confronted with many price-affecting choices related to coupons and that he usually is seeking low prices [col 2 lines 53-57]. Understanding the choice of optimum purchase requires an understanding of coupon procedures (i.e. rules) and unit pricing techniques [col 3 lines 20-22]. The calculations done by the system of Fajkowski consider the impact of the coupon and the optimum choice, i.e. lowest until price is indicated to the user [col 3 lines 51-53]. Fajkowski's system accomplishes the automated eligibility determination and it would have been obvious to one of ordinary skill at the time of the invention to have also provided automated coupon optimization assistance (i.e. indicating the best coupon(s) to use in order to best reduce the price given the subset of eligible coupons possessed) to customers faced with navigating the coupon rules and options imposed by the retailer. This would enable the customer to most benefit from his coupons, deliver the lowest prices as is generally desired as well as encourage purchasing of retailer products.

B. APPELLANT'S POSITION

To summarize, Appellant submits that in the Examiner's position is flawed as a matter of fact and law.

Dependent claims 2, 4-5, 7 and 67 are patentable not only because they depend from a patentable claim, but also because of the additional features they define.

Dependent claims 16, 18-19 and 69-70 are patentable not only because they depend from a patentable claim, but also because of the additional features they define.

Dependent claims 23-27, 30-31 and 33-35 are patentable not only because they depend from a patentable claim, but also because of the additional features they define.

Dependent claims 50-54, 57 and 59-61 are patentable not only because they depend from a patentable claim, but also because of the additional features they define.

Dependent claims 64 and 66 are patentable not only because they depend from a patentable claim, but also because of the additional features they define.

1. The 35 U.S.C. § 103(a) Rejection over Fajkowski

Claims 1-2, 4-5, 7, 15-16, 18-19, 22-27, 30-31, 33, 35, 49-54, 57, 59, 61-62 and 66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski, U.S. Pat. No. 6,932,270, (hereinafter “Fajkowski”).

The Examiner alleges that one of ordinary skill in the art would have been motivated to modify Fajkowski to form the invention of claims 1-2, 4-5, 7, 15-16, 18-19, 22-27, 30-31, 33, 35, 49-54, 57, 59, 61-62 and 66. Appellant submits, however that Fajkowski does not teach or suggest each element of the claimed invention.

Appellant traverses the Examiner’s rejection since, among other reasons, Fajkowski is directed toward the creation of a user-segregated coupon “shopping list” for presentation to a POS terminal after purchase, and a “raincheck” marked list of coupons that allows a customer to utilize a coupon after its expiration date. Meanwhile, Appellant’s claimed invention is directed toward recommending to a user to use an additional e-coupon in relation to a purchase based on choosing one particular saved set of e-coupons.

A. Appellant submits, that Fajkowski fails to teach or suggest, “before said user makes said purchase, outputting a suggestion to said user, by said computer, displaying said most favorable combination of non-mutually exclusive e-coupons,” according to Appellant’s independent claims 1, 15, 22 and 49, and similarly, “output a suggestion to said user displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons,...before said user makes said purchase,” according to Appellant’s independent claim 62.

The Examiner on page 3 of the Non-Final Office Action with respect to independent claims, 1, 15, 22 and 49, (the Examiner fails to address these limitations in Appellant’s independent claim 62), alleges that Fajkowski discloses that “[w]hen the card is presented at

the POS along with scanned products to be purchased (i.e. before the purchase is completed by way of accepting payment - and therefore, "before purchase"), the POS system determines what coupons of the user's collection of selected coupons are redeemable given the user's scanned products; the system displays these coupons on the display [16:18-31, 17:31-33,4:25-35]."

Appellant maintains that Fajkowski fails to teach outputting a suggestion to a user before a purchase, and in fact, teaches away from Appellant's claimed invention by disclosing that the "products were purchased by the consumer," thereafter, a "list of redeemable coupons will then be displayed on the periphery device." (Emphasis added.) See column 4, lines 26-35. The Examiner's statement on page 25 of the Non-Final Office Action is completely contrary to the plain meaning of the description of Fajkowski. The disclosure of column 17 in Fajkowski that the Examiner alludes to merely states that, "If the customer is satisfied that display screen 102 shows all his redeemable coupons, the cashier will again press the "List/Send" key 108 and the redeemable coupon bar codes 50 will be transferred to cash register 150 (step 176)." Nowhere in this passage, or anywhere else in Fajkowski is there any teaching or suggestion that the redeemable coupons are "transferred to cash register 150" before said user makes said purchase, which is consistent with Fajkowski's disclosure stated above that the "list of redeemable coupons will then be displayed" once the "products were purchased by the consumer." The Examiner cannot interject his own ideas of what he would like to see the reference teach when the reference clearly teaches something to the contrary, no matter how awkward that disclosure may be.

B. Appellant submits, that Fajkowski fails to teach or suggest, "saving said displayed most favorable combination of non-mutually exclusive e-coupons... and choosing another subset of said e-coupons," according to Appellant's independent claims 1 and 15,

and similarly, independent claims 22 and 49, and similarly, “a storage device adapted to save said displayed most favorable combination of non-mutually exclusive e-coupons...wherein one of saved sets of e-coupons is chosen based on comparing two or more of said saved sets of e-coupons,” according to Appellant's independent claim 62.

The Examiner on page 5 of the Non-Final Office Action with respect to independent claims, 1, 15, 22 and 49, (the Examiner fails to specifically address these limitations in Appellant's independent claim 62), alleges that Fajkowski discloses “[r]egarding the saved coupons, the choosing among them and recommending based on the saved coupons, Fajkowski teaches that the user may save shopping lists with specified coupons for the products on the list to be used on future shopping trips [13:14- 41]. Fajkowski also teaches the idea of issuing a rain check for a coupon item the user wishes to purchase, but where the item is currently unavailable. The system will save such a list of rain-checked product(s) for later use. In either case, future use of the saved lists are taken to meet the broad "comparing" by a user. Further, the art describes the capability to save any number of coupons which enables saving combinations of coupons.”

Appellant's claimed invention is directed toward a combination of non-mutually exclusive e-coupons, and another sub-set of the e-coupons. The disclosure of Fajkowski cited by the Examiner on column 13, lines 14-42, details either immediately after scanning the coupon or after a coupon has been stored in RAM means 23 the user selects particular coupons to “segregate” them to a “shopping list”. More specifically, Fajkowski discloses at column 13, lines 15-17, “This routine will allow the user to segregate coupons for specific products that the user desires to purchase during a future shopping trip.” Therefore, it is the “user” that segregates the coupons to a “shopping list” and not, a computer implemented method of, “outputting a suggestion to said user, by said computer, displaying said most

favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons,” per Appellant's claimed invention.

C. Appellant submits, that Fajkowski fails to teach or suggest, “choosing one of saved sets of e-coupons based on comparing two or more of said saved sets of e-coupons,” according to Appellant's independent claims 1 and 15, and similarly, “comparing by a user two or more saved sets of e-coupons and choosing one of saved sets of e-coupons,” according to Appellant's independent claims 22 and 49.

The Examiner intimates on page 5 of the Non-Final Office Action that the portion of Fajkowski disclosing the issuance of a “rain-check” is equivalent to Appellant's claimed, “another sub-set of said e-coupons.” Fajkowski discloses that, “[w]hen a customer has on his coupon card a coupon for an item which is out of stock and the coupon is about to expire, the store may place a marker on the coupon indicating it has been made available for rainchecking.”

However, using the Examiner's logic of equating the elements of Fajkowski with Appellant's claimed invention, nowhere in Fajkowski, nor in any other cited art of record is there any teaching or suggestion that demonstrates choosing either the “shopping list” of user-segregated coupons OR the rainchecked marked coupons based on comparing the user-segregated coupons and the rainchecked marked coupons, per Appellant's claimed invention. The user-segregated coupons are used after the user has purchased the items per Fajkowski's disclosure at column 17, and the raincheck marked coupons are used to merely allow a customer to “utilize the coupon after its expiration date,” from column 20, lines 39-47. There is no comparison between either of these “lists,” since each “list” is disclosed as being used independently of the other. Though the “raincheck” marked coupons are generated from the predetermined user-segregated coupon “shopping list” upon the determination of one or more

item's unavailability at the time of sale, neither list is compared to the other for the purposes of choosing to use one list over other the other in a checkout POS transaction.

D. Appellant submits, that Fajkowski fails to teach or suggest, "recommending to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons," according to Appellant's independent claims 1, 15, 22 and 49, and similarly, "wherein said user interface communicates a recommendation to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons," according to Appellant's independent claim 62.

The Examiner states on pages 4 and 6 of the Non-Final Office Action that, "Fajkowski's system is also quite intelligent in that **it can recommend an additional purchase** when a consumer possesses a valuable coupon, but has not fully met the purchasing qualifications (perhaps the user chose the wrong size product) [19:38-43]."

However, Appellant's claimed invention claims, "recommending to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons," NOT recommending **an additional purchase** in relation to the customer's existing purchase, and certainly not based on choosing either the user-segregated coupon "shopping list" or the "raincheck" marked coupons, as argued above in section C.

The Examiner states on page 5 of the Non-Final Office Action that, "Regarding the saved coupons, the choosing among them and **recommending** based on the saved coupons, Fajkowski teaches that the user may save shopping lists with specified coupons for the products on the list to be used on future shopping trips [13:14-41]. Fajkowski also teaches the idea of issuing a rain check for a coupon item the user wishes to purchase, but where the item is currently unavailable. The system will save such a list of rain-checked product(s) for later use. In either case, future use of the saved lists are taken to meet the broad "comparing" by a

user. Further, the art describes the capability to save any number of coupons which enables saving combinations of coupons.” However, as argued in the above paragraph, nowhere does Fajkowski teach or suggest recommending to a user to use *an additional e-coupon* in relation to user’s purchase, or recommending based on choosing either the user-segregated coupon “shopping list” or the “raincheck” marked coupons, as argued above in section C.

The Examiner states on page 6 of the Non-Final Office Action that, “It would have been obvious to one of ordinary skill at the time of the invention for the system's coupon(s) **recommendations** to have included coupons that had been "saved". Further still, Fajkowski's also teaches that **the system can recommend an additional purchase** when a consumer possesses a valuable coupon, but has not fully met the purchasing qualifications (perhaps the user chose the wrong size product) [19:38-43].” Again, per Appellant's argument in the above paragraphs, Appellant's claimed invention claims, “*recommending to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons,*” NOT recommending **an additional purchase** in relation to the customer's existing purchase, and certainly not based on choosing either the user-segregated coupon “shopping list” or the “raincheck” marked coupons, as argued above in section C.

Therefore, the Examiner's allegations of motivation to modify Fajkowski with the level skill of one of ordinary skill in the art, *i.e.*, “[i]t would have been obvious to one of ordinary skill at the time of **the invention to have recommended** the use of saved coupon where the user is close to an optimized coupon eligibility, but needs to make slight changes to his products for purchase;” and that “[i]t would have been obvious to one of ordinary skill at the time of **the invention to have recommended** this additional coupon even if this is a coupon that had been previously saved,” is erroneous since **nowhere in the disclosure of Fajkowski, and nowhere has the Examiner provided the requisite evidence of the level of one**

of ordinary skill in the art to “recommend to a user to use an additional e-coupon in relation to a purchase based on choosing saved sets of e-coupons.”

In summary, Fajkowski is directed toward the creation of a user-segregated coupon “shopping list” for presentation to a POS terminal after purchase, and a “raincheck” marked list of coupons that allows a customer to utilize a coupon after its expiration date. Whereas, Appellant’s claimed invention is directed toward recommending to a user to use an additional e-coupon in relation to a purchase based on choosing one particular saved set of e-coupons.

Therefore, Appellant respectfully requests the Board to reconsider and withdraw this rejection since the alleged prior art reference to Fajkowski fails to teach or suggest each element and feature of Appellant’s claimed invention.

2. The 35 U.S.C. § 103(a) Rejection over Fajkowski further in view of Marmon

Claims 1-2, 4-5, 7, 15-16, 18-19, 22-31, 33, 35, 40-57, 59, 61-62 and 66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski, further in view of Marmon, U.S. Pat. No. 4,446,528, (hereinafter “Marmon”).

The Examiner alleges at the bottom of page 8 of the Non-Final Office Action that one of ordinary skill in the art would have been motivated to modify Fajkowski with the teaching from Marmon to form the invention of claims 1-2, 4-5, 7, 15-16, 18-19, 22-31, 33, 35, 40-57, 59, 61-62 and 66. Appellant submits, however that these references would not have been combined and even if combined, the combination would not teach or suggest each element of the claimed invention.

Appellant traverses the Examiner’s rejection since, among other reasons, Fajkowski is directed toward the creation of a user-segregated coupon “shopping list” for presentation to a

POS terminal after purchase, and a “raincheck” marked list of coupons that allows a customer to utilize a coupon after its expiration date. Meanwhile, Appellant’s claimed invention is directed toward recommending to a user to use an additional e-coupon in relation to a purchase based on choosing one particular saved set of e-coupons.

A. Appellant submits, that Fajkowski fails to teach or suggest, “before said user makes said purchase, outputting a suggestion to said user, by said computer, displaying said most favorable combination of non-mutually exclusive e-coupons,” according to Appellant’s independent claims 1, 15, 22 and 49, and similarly, “output a suggestion to said user displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons,...before said user makes said purchase,” according to Appellant’s independent claim 62.

The Examiner on page 9 of the Non-Final Office Action with respect to independent claims, 1, 15, 22 and 49, (the Examiner fails to address these limitations in Appellant’s independent claim 62), alleges that Fajkowski discloses that “[w]hen the card is presented at the POS along with scanned products to be purchased (i.e. before the purchase is completed by way of accepting payment - and therefore, "before purchase"), the POS system determines what coupons of the user's collection of selected coupons are redeemable given the user's scanned products; the system displays these coupons on the display [16:18-31, 17:31-33,4:25-35].”

Appellant maintains that Fajkowski fails to teach outputting a suggestion to a user before a purchase, and in fact, teaches away from Appellant’s claimed invention by disclosing that the “products were purchased by the consumer,” thereafter, a “list of redeemable coupons will then be displayed on the periphery device.” (Emphasis added.) See column 4, lines 26-35. The Examiner’s statement on page 25 of the Non-Final Office Action is

completely contrary to the plain meaning of the description of Fajkowski. The disclosure of column 17 in Fajkowski that the Examiner alludes to merely states that, “If the customer is satisfied that display screen 102 shows all his redeemable coupons, the cashier will again press the “List/Send” key 108 and the redeemable coupon bar codes 50 will be transferred to cash register 150 (step 176).” Nowhere in this passage, or anywhere else in Fajkowski is there any teaching or suggestion that the redeemable coupons are “transferred to cash register 150” *before said user makes said purchase*, which is consistent with Fajkowski’s disclosure stated above that the “list of redeemable coupons will then be displayed” once the “products were purchased by the consumer.” The Examiner cannot interject his own ideas of what he would like to see the reference teach when the reference clearly teaches something to the contrary, no matter how awkward that disclosure may be.

B. Appellant submits, that Fajkowski fails to teach or suggest, “*saving said displayed most favorable combination of non-mutually exclusive e-coupons... and choosing another subset of said e-coupons*,” according to Appellant’s independent claims 1 and 15, and similarly, independent claims 22 and 49, and similarly, “*a storage device adapted to save said displayed most favorable combination of non-mutually exclusive e-coupons...wherein one of saved sets of e-coupons is chosen based on comparing two or more of said saved sets of e-coupons*,” according to Appellant’s independent claim 62.

The Examiner on page 11 of the Non-Final Office Action with respect to independent claims, 1, 15, 22 and 49, (the Examiner fails to specifically address these limitations in Appellant’s independent claim 62), alleges that Fajkowski discloses “Regarding the saved coupons, the choosing among them and recommending based on the saved coupons, Fajkowski teaches that the user may save shopping lists with specified coupons for the products on the list to be used on future shopping trips [13:14- 41]. Fajkowski also teaches

the idea of issuing a rain check for a coupon item the user wishes to purchase, but where the item is currently unavailable. The system will save such a list of rain-checked product(s) for later use. In either case, future use of the saved lists are taken to meet the broad "comparing" by a user. Further, the art describes the capability to save any number of coupons which enables saving combinations of coupons."

Appellant's claimed invention is directed toward a combination of non-mutually exclusive e-coupons, and another sub-set of the e-coupons. The disclosure of Fajkowski cited by the Examiner on column 13, lines 14-42, details either immediately after scanning the coupon or after a coupon has been stored in RAM means 23 the user selects particular coupons to "segregate" them to a "shopping list". More specifically, Fajkowski discloses at column 13, lines 15-17, "This routine will allow the user to segregate coupons for specific products that the user desires to purchase during a future shopping trip." Therefore, it is the "user" that segregates the coupons to a "shopping list" and not, a computer implemented method of, "outputting a suggestion to said user, by said computer, displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons," per Appellant's claimed invention.

C. Appellant submits, that Fajkowski fails to teach or suggest, "choosing one of saved sets of e-coupons based on comparing two or more of said saved sets of e-coupons," according to Appellant's independent claims 1 and 15, and similarly, "comparing by a user two or more saved sets of e-coupons and choosing one of saved sets of e-coupons," according to Appellant's independent claims 22 and 49.

The Examiner intimates on page 11 of the Non-Final Office Action that the portion of Fajkowski disclosing the issuance of a "rain-check" is equivalent to Appellant's claimed, "another sub-set of said e-coupons." Fajkowski discloses that, "[w]hen a customer has on his

coupon card a coupon for an item which is out of stock and the coupon is about to expire, the store may place a marker on the coupon indicating it has been made available for rainchecking.”

However, using the Examiner's logic of equating the elements of Fajkowski with Appellant's claimed invention, nowhere in Fajkowski, nor in any other cited art of record is there any teaching or suggestion that demonstrates choosing either the “shopping list” of user-segregated coupons OR the rainchecked marked coupons based on comparing the user-segregated coupons and the rainchecked marked coupons, per Appellant's claimed invention. The user-segregated coupons are used after the user has purchased the items per Fajkowski's disclosure at column 17, and the raincheck marked coupons are used to merely allow a customer to “utilize the coupon after its expiration date,” from column 20, lines 39-47. There is no comparison between either of these “lists,” since each “list” is disclosed as being used independently of the other. Though the “raincheck” marked coupons are generated from the predetermined user-segregated coupon “shopping list” upon the determination of one or more item's unavailability at the time of sale, neither list is compared to the other for the purposes of choosing to use one list over other the other in a checkout POS transaction.

D. Appellant submits, that Fajkowski fails to teach or suggest, “recommending to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons,” according to Appellant's independent claims 1, 15, 22 and 49, and similarly, “wherein said user interface communicates a recommendation to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons,” according to Appellant's independent claim 62.

The Examiner states on page 11 of the Non-Final Office Action that, “Fajkowski's system is also quite intelligent in that it can recommend an additional purchase when a

consumer possesses a valuable coupon, but has not fully met the purchasing qualifications (perhaps the user chose the wrong size product) [19:38-43].” However, Appellant's claimed invention claims, “recommending to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons,” NOT recommending **an additional purchase** in relation to the customer's existing purchase, and certainly not based on choosing either the user-segregated coupon “shopping list” or the “raincheck” marked coupons, as argued above in section C.

The Examiner states on page 11 of the Non-Final Office Action that, “Regarding the saved coupons, the choosing among them and **recommending** based on the saved coupons, Fajkowski teaches that the user may save shopping lists with specified coupons for the products on the list to be used on future shopping trips [13:14- 41]. Fajkowski also teaches the idea of issuing a rain check for a coupon item the user wishes to purchase, but where the item is currently unavailable. The system will save such a list of rain-checked product(s) for later use. In either case, future use of the saved lists are taken to meet the broad "comparing" by a user. Further, the art describes the capability to save any number of coupons which enables saving combinations of coupons.” However, as argued in the above paragraph, nowhere does Fajkowski teach or suggest recommending to a user to use *an additional e-coupon* in relation to user's purchase, or recommending based on choosing either the user-segregated coupon “shopping list” or the “raincheck” marked coupons, as argued above in section C.

The Examiner states on page 11 of the Non-Final Office Action that, “It would have been obvious to one of ordinary skill at the time of the invention for the system's coupon(s) **recommendations** to have included coupons that had been "saved". Further still, Fajkowski's also teaches that **the system can recommend an additional purchase** when a consumer

possesses a valuable coupon, but has not fully met the purchasing qualifications (perhaps the user chose the wrong size product) [19:38-43].” Again, per Appellant's argument in the above paragraphs, Appellant's claimed invention claims, “recommending to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons,” NOT recommending an additional purchase in relation to the customer's existing purchase, and certainly not based on choosing either the user-segregated coupon “shopping list” or the “raincheck” marked coupons, as argued above in section C.

Therefore, the Examiner's allegations of motivation to modify Fajkowski with the level skill of one of ordinary skill in the art, *i.e.*, “[i]t would have been obvious to one of ordinary skill at the time of the invention to have recommended the use of saved coupon where the user is close to an optimized coupon eligibility, but needs to make slight changes to his products for purchase;” and that “[i]t would have been obvious to one of ordinary skill at the time of the invention to have recommended this additional coupon even if this is a coupon that had been previously saved,” is erroneous since nowhere in the disclosure of Fajkowski, and nowhere has the Examiner provided the requisite evidence of the level of one of ordinary skill in the art to “recommend to a user to use an additional e-coupon in relation to a purchase based on choosing saved sets of e-coupons.”

In summary, Fajkowski is directed toward the creation of a user-segregated coupon “shopping list” for presentation to a POS terminal after purchase, and a “raincheck” marked list of coupons that allows a customer to utilize a coupon after its expiration date. Whereas, Appellant's claimed invention is directed toward recommending to a user to use an additional e-coupon in relation to a purchase based on choosing one particular saved set of e-coupons.

E. The Examiner on page 9 of the Non-Final Office Action state with respect to the combination of Marmon with Fajkowski:

Marmon teaches that shopping can get quite complicated when pricing systems are combined with cents off coupons and retailers offer to double or triple coupons [col 1 lines 38-42]. Fajkowski provides a calculating tool for optimizing purchasing decisions affected by the complex pricing combinations that include coupons [col 1 lines 50-60]. Marmon notes that the consumer is confronted with many price-affecting choices related to coupons and that he usually is seeking low prices [col 2 lines 53-57]. Understanding the choice of optimum purchase requires an understanding of coupon procedures (i.e. rules) and unit pricing techniques [col 3 lines 20-22]. The calculations done by the system of Fajkowski consider the impact of the coupon and the optimum choice, i.e. lowest until price is indicated to the user [col 3 lines 51-53].

Appellant fails to understand what elements of Appellant's claimed invention

Fajkowski fails to teach or suggest that necessitate a combination with the Marmon reference.

Alternatively stated, Applicant maintains that this rejection over the combination of Wajkowski and Marmon is NOT proper since the Examiner fails to identify what elements of Appellant's claimed invention are NOT taught by Fajkowski and which elements of Marmon teach those missing elements and why one of ordinary skill in the art would have combined the references based on either teaching within the references or the demonstration with evidence of the level of one of ordinary skill in the art.

Therefore, Appellant respectfully requests the Board to reconsider and withdraw this rejection since the alleged prior art references to Fajkowski and Marmon (either alone or in combination) fail to teach or suggest each element and feature of Appellant's claimed invention.

3. The 35 U.S.C. § 103(a) Rejection over Fajkowski further in view of Wilkman

Claims 1-2, 4-5, 7, 15-16, 18-19, 22-31, 33, 35, 40-57, 59, 61-62 and 66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski, further in view of Wilkman, U.S. Pat. App. Pub. No. 2002/0013728, (hereinafter "Wilkman").

The Examiner alleges on the bottom of page 13 of the Non-Final Office Action that one of ordinary skill in the art would have been motivated to modify Fajkowski with the teaching from Wilkman to form the invention of claims 1-2, 4-5, 7, 15-16, 18-19, 22-31, 33, 35, 40-57, 59, 61-62 and 66. Appellant submits, however that these references would not have been combined and even if combined, the combination would not teach or suggest each element of the claimed invention.

Appellant traverses the Examiner's rejection since, among other reasons, Fajkowski is directed toward the creation of a user-segregated coupon "shopping list" for presentation to a POS terminal after purchase, and a "raincheck" marked list of coupons that allows a customer to utilize a coupon after its expiration date. Meanwhile, Appellant's claimed invention is directed toward recommending to a user to use an additional e-coupon in relation to a purchase based on choosing one particular saved set of e-coupons.

A. Appellant submits, that Fajkowski fails to teach or suggest, "before said user makes said purchase, outputting a suggestion to said user, by said computer, displaying said most favorable combination of non-mutually exclusive e-coupons," according to Appellant's independent claims 1, 15, 22 and 49, and similarly, "output a suggestion to said user displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons,...before said user makes said purchase," according to Appellant's independent claim 62.

The Examiner on page 15 of the Non-Final Office Action with respect to independent claims, 1, 15, 22 and 49, (the Examiner fails to address these limitations in Appellant's independent claim 62), alleges that Fajkowski discloses that "[w]hen the card is presented at the POS along with scanned products to be purchased (i.e. before the purchase is completed by way of accepting payment - and therefore, "before purchase"), the POS system

determines what coupons of the user's collection of selected coupons are redeemable given the user's scanned products; the system displays these coupons on the display [16:18-31, 17:31-33,4:25-35].”

Appellant maintains that Fajkowski fails to teach outputting a suggestion to a user before a purchase, and in fact, teaches away from Appellant's claimed invention by disclosing that the “products were purchased by the consumer,” thereafter, a “list of redeemable coupons will then be displayed on the periphery device.” (Emphasis added.) See column 4, lines 26-35. The Examiner's statement on page 25 of the Non-Final Office Action is completely contrary to the plain meaning of the description of Fajkowski. The disclosure of column 17 in Fajkowski that the Examiner alludes to merely states that, “If the customer is satisfied that display screen 102 shows all his redeemable coupons, the cashier will again press the "List/Send" key 108 and the redeemable coupon bar codes 50 will be transferred to cash register 150 (step 176).” Nowhere in this passage, or anywhere else in Fajkowski is there any teaching or suggestion that the redeemable coupons are “transferred to cash register 150” before said user makes said purchase, which is consistent with Fajkowski's disclosure stated above that the “list of redeemable coupons will then be displayed” once the “products were purchased by the consumer.” The Examiner cannot interject his own ideas of what he would like to see the reference teach when the reference clearly teaches something to the contrary, no matter how awkward that disclosure may be.

B. Appellant submits, that Fajkowski fails to teach or suggest, “saving said displayed most favorable combination of non-mutually exclusive e-coupons... and choosing another subset of said e-coupons,” according to Appellant's independent claims 1 and 15, and similarly, independent claims 22 and 49, and similarly, “a storage device adapted to save said displayed most favorable combination of non-mutually exclusive e-coupons...wherein

one of saved sets of e-coupons is chosen based on comparing two or more of said saved sets of e-coupons," according to Appellant's independent claim 62.

The Examiner on page 17 of the Non-Final Office Action with respect to independent claims, 1, 15, 22 and 49, (the Examiner fails to specifically address these limitations in Appellant's independent claim 62), alleges that Fajkowski discloses “[r]egarding the saved coupons, the choosing among them and recommending based on the saved coupons, Fajkowski teaches that the user may save shopping lists with specified coupons for the products on the list to be used on future shopping trips [13:14- 41]. Fajkowski also teaches the idea of issuing a rain check for a coupon item the user wishes to purchase, but where the item is currently unavailable. The system will save such a list of rain-checked product(s) for later use. In either case, future use of the saved lists are taken to meet the broad "comparing" by a user. Further, the art describes the capability to save any number of coupons which enables saving combinations of coupons.”

Appellant's claimed invention is directed toward a combination of non-mutually exclusive e-coupons, and another sub-set of the e-coupons. The disclosure of Fajkowski cited by the Examiner on column 13, lines 14-42, details either immediately after scanning the coupon or after a coupon has been stored in RAM means 23 the user selects particular coupons to “segregate” them to a “shopping list”. More specifically, Fajkowski discloses at column 13, lines 15-17, “This routine will allow the user to segregate coupons for specific products that the user desires to purchase during a future shopping trip.” Therefore, it is the “user” that segregates the coupons to a “shopping list” and not, a computer implemented method of, “outputting a suggestion to said user, by said computer, displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons,” per Appellant's claimed invention.

C. Appellant submits, that Fajkowski fails to teach or suggest, “choosing one of saved sets of e-coupons based on comparing two or more of said saved sets of e-coupons,” according to Appellant's independent claims 1 and 15, and similarly, “comparing by a user two or more saved sets of e-coupons and choosing one of saved sets of e-coupons,” according to Appellant's independent claims 22 and 49.

The Examiner intimates on page 17 of the Non-Final Office Action that the portion of Fajkowski disclosing the issuance of a “rain-check” is equivalent to Appellant's claimed, “another sub-set of said e-coupons.” Fajkowski discloses that, “[w]hen a customer has on his coupon card a coupon for an item which is out of stock and the coupon is about to expire, the store may place a marker on the coupon indicating it has been made available for rainchecking.”

However, using the Examiner's logic of equating the elements of Fajkowski with Appellant's claimed invention, nowhere in Fajkowski, nor in any other cited art of record is there any teaching or suggestion that demonstrates choosing either the “shopping list” of user-segregated coupons OR the rainchecked marked coupons based on comparing the user-segregated coupons and the rainchecked marked coupons, per Appellant's claimed invention. The user-segregated coupons are used after the user has purchased the items per Fajkowski's disclosure at column 17, and the raincheck marked coupons are used to merely allow a customer to “utilize the coupon after its expiration date,” from column 20, lines 39-47. There is no comparison between either of these “lists,” since each “list” is disclosed as being used independently of the other. Though the “raincheck” marked coupons are generated from the predetermined user-segregated coupon “shopping list” upon the determination of one or more item's unavailability at the time of sale, neither list is compared to the other for the purposes of choosing to use one list over other the other in a checkout POS transaction.

D. Appellant submits, that Fajkowski fails to teach or suggest, “recommending to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons,” according to Appellant's independent claims 1, 15, 22 and 49, and similarly, “wherein said user interface communicates a recommendation to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons,” according to Appellant's independent claim 62.

The Examiner states on page 16 of the Non-Final Office Action that, “Fajkowski's system is also quite intelligent in that **it can recommend an additional purchase** when a consumer possesses a valuable coupon, but has not fully met the purchasing qualifications (perhaps the user chose the wrong size product) [19:38-43].” However, Appellant's claimed invention claims, “recommending to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons,” NOT recommending **an additional purchase** in relation to the customer's existing purchase, and certainly not based on choosing either the user-segregated coupon “shopping list” or the “raincheck” marked coupons, as argued above in section C.

The Examiner states on page 17 of the Non-Final Office Action that, “Regarding the saved coupons, the choosing among them and **recommending** based on the saved coupons, Fajkowski teaches that the user may save shopping lists with specified coupons for the products on the list to be used on future shopping trips [13:14-41]. Fajkowski also teaches the idea of issuing a rain check for a coupon item the user wishes to purchase, but where the item is currently unavailable. The system will save such a list of rain-checked product(s) for later use. In either case, future use of the saved lists are taken to meet the broad "comparing" by a user. Further, the art describes the capability to save any number of coupons which enables saving combinations of coupons.” However, as argued in the above paragraph, nowhere does

Fajkowski teach or suggest recommending to a user to use *an additional e-coupon* in relation to user's purchase, or recommending based on choosing either the user-segregated coupon "shopping list" or the "raincheck" marked coupons, as argued above in section C.

The Examiner states on page 17 of the Non-Final Office Action that, "It would have been obvious to one of ordinary skill at the time of the invention for the system's coupon(s) **recommendations** to have included coupons that had been "saved". Further still, Fajkowski's also teaches that **the system can recommend an additional purchase** when a consumer possesses a valuable coupon, but has not fully met the purchasing qualifications (perhaps the user chose the wrong size product) [19:38-43]." Again, per Appellant's argument in the above paragraphs, Appellant's claimed invention claims, "*recommending to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons,*" NOT recommending **an additional purchase** in relation to the customer's existing purchase, and certainly not based on choosing either the user-segregated coupon "shopping list" or the "raincheck" marked coupons, as argued above in section C.

Therefore, the Examiner's allegations of motivation to modify Fajkowski with the level skill of one of ordinary skill in the art, *i.e.*, "[i]t would have been obvious to one of ordinary skill at the time of **the invention to have recommended** the use of saved coupon where the user is close to an optimized coupon eligibility, but needs to make slight changes to his products for purchase;" and that "[i]t would have been obvious to one of ordinary skill at the time of **the invention to have recommended** this additional coupon even if this is a coupon that had been previously saved," is erroneous since *nowhere in the disclosure of Fajkowski, and nowhere has the Examiner provided the requisite evidence of the level of one of ordinary skill in the art to "recommend to a user to use an additional e-coupon in relation to a purchase based on choosing saved sets of e-coupons."*

In summary, Fajkowski is directed toward the creation of a user-segregated coupon “shopping list” for presentation to a POS terminal after purchase, and a “raincheck” marked list of coupons that allows a customer to utilize a coupon after its expiration date. Whereas, Appellant’s claimed invention is directed toward recommending to a user to use an additional e-coupon in relation to a purchase based on choosing one particular saved set of e-coupons.

E. The Examiner on page 16 of the Non-Final Office Action state with respect to the combination of Wilkman with Fajkowski:

Wilkman also recognizes the variety of incentive offers available to purchasing consumers and he teaches the use of a computer-based optimization routine that takes the legwork out of manually analyzing the variety of eligible combinations and benefits (price, coupons, promotions, loyalty, etc.) in order to provide the best benefit for the consumer [abstract]. It would have been obvious to one of ordinary skill at the time of the invention to have provided systems and methods that provide assistance to customers faced with navigating the recognized (albeit in some cases difficult or confusing) coupon rules and options imposed by the incentive providers. Rather than take the time and energy to manually track all of the provided options, restrictions and benefits, It would have been obvious to one of ordinary skill at the time of the invention to have provided a computer system to optimize the ‘non trivial’ combination of coupon restrictions and benefits, so that the consumer need not be burdened with the research (although it is well accepted that in the past the research has been capably done manually).

Appellant fails to understand what elements of Appellant's claimed invention Fajkowski fails to teach or suggest that necessitate a combination with the Wilkman reference. Alternatively stated, Applicant maintains that this rejection over the combination of Wajkowski and Wilkman is NOT proper since the Examiner fails to identify what elements of Appellant's claimed invention are NOT taught by Fajkowski and which elements of Wilkman teach those missing elements and why one of ordinary skill in the art would have combined the references based on either teaching within the references or the demonstration with evidence of the level of one of ordinary skill in the art.

Therefore, Appellant respectfully requests the Board to reconsider and withdraw this

rejection since the alleged prior art references to Fajkowski and Wilkman (either alone or in combination) fail to teach or suggest each element and feature of Appellant's claimed invention.

4. The 35 U.S.C. § 103(a) Rejection over Fajkowski further in view of Wilkman and Marmon

Claims 1-2, 4-5, 7, 15-16, 18-19, 22-31, 33, 35, 40-57, 59, 61-62 and 66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski further in view of Wilkman and Marmon.

The Examiner alleges at page 19 of the Non-Final Office Action that one of ordinary skill in the art would have been motivated to modify Fajkowski with the teachings from Wilkman and Marmon to form the invention of claims 1-2, 4-5, 7, 15-16, 18-19, 22-31, 33, 35, 40-57, 59, 61-62 and 66. Appellant submits, however that these references would not have been combined and even if combined, the combination would not teach or suggest each element of the claimed invention.

Appellant traverses the Examiner's rejection since, among other reasons, Fajkowski is directed toward the creation of a user-segregated coupon "shopping list" for presentation to a POS terminal after purchase, and a "raincheck" marked list of coupons that allows a customer to utilize a coupon after its expiration date. Meanwhile, Appellant's claimed invention is directed toward recommending to a user to use an additional e-coupon in relation to a purchase based on choosing one particular saved set of e-coupons.

A. Appellant submits, that Fajkowski fails to teach or suggest, "before said user makes said purchase, outputting a suggestion to said user, by said computer, displaying said most favorable combination of non-mutually exclusive e-coupons," according to Appellant's

independent claims 1, 15, 22 and 49, and similarly, “output a suggestion to said user displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons,...before said user makes said purchase,” according to Appellant's independent claim 62.

The Examiner in this rejection beginning on page 20 of the Non-Final Office Action with respect to independent claims, 1, 15, 22, 49 and 62, fails to address any of Appellant's claimed limitations with respect to Fajkowski.

Appellant, assuming *arguendo*, that the Examiner maintains the rejection of Fajkowski from the previous rejections, the Examiner alleges that Fajkowski discloses that “[w]hen the card is presented at the POS along with scanned products to be purchased (i.e. before the purchase is completed by way of accepting payment - and therefore, "before purchase"), the POS system determines what coupons of the user's collection of selected coupons are redeemable given the user's scanned products; the system displays these coupons on the display [16:18-31, 17:31-33,4:25-35].”

Appellant maintains that Fajkowski fails to teach outputting a suggestion to a user before a purchase, and in fact, teaches away from Appellant's claimed invention by disclosing that the “products were purchased by the consumer,” thereafter, a “list of redeemable coupons will then be displayed on the periphery device.” (Emphasis added.) See column 4, lines 26-35. The Examiner's statement on page 25 of the Non-Final Office Action is completely contrary to the plain meaning of the description of Fajkowski. The disclosure of column 17 in Fajkowski that the Examiner alludes to merely states that, “If the customer is satisfied that display screen 102 shows all his redeemable coupons, the cashier will again press the "List/Send" key 108 and the redeemable coupon bar codes 50 will be transferred to cash register 150 (step 176).” Nowhere in this passage, or anywhere else in Fajkowski is

there any teaching or suggestion that the redeemable coupons are “transferred to cash register 150” before said user makes said purchase, which is consistent with Fajkowski’s disclosure stated above that the “list of redeemable coupons will then be displayed” once the “products were purchased by the consumer.” The Examiner cannot interject his own ideas of what he would like to see the reference teach when the reference clearly teaches something to the contrary, no matter how awkward that disclosure may be.

B. Appellant submits, that Fajkowski fails to teach or suggest, “saving said displayed most favorable combination of non-mutually exclusive e-coupons... and choosing another subset of said e-coupons,” according to Appellant’s independent claims 1 and 15, and similarly, independent claims 22 and 49, and similarly, “a storage device adapted to save said displayed most favorable combination of non-mutually exclusive e-coupons...wherein one of saved sets of e-coupons is chosen based on comparing two or more of said saved sets of e-coupons,” according to Appellant’s independent claim 62.

The Examiner in this rejection beginning on page 20 of the Non-Final Office Action with respect to independent claims, 1, 15, 22, 49 and 62, fails to address any of Appellant’s claimed limitations with respect to Fajkowski.

Appellant, assuming *arguendo*, that the Examiner maintains the rejection of Fajkowski from the previous rejections, the Examiner alleges that Fajkowski discloses “Regarding the saved coupons, the choosing among them and recommending based on the saved coupons, Fajkowski teaches that the user may save shopping lists with specified coupons for the products on the list to be used on future shopping trips [13:14- 41]. Fajkowski also teaches the idea of issuing a rain check for a coupon item the user wishes to purchase, but where the item is currently unavailable. The system will save such a list of rain-checked product(s) for later use. In either case, future use of the saved lists are taken to meet

the broad "comparing" by a user. Further, the art describes the capability to save any number of coupons which enables saving combinations of coupons."

Appellant's claimed invention is directed toward a combination of non-mutually exclusive e-coupons, and another sub-set of the e-coupons. The disclosure of Fajkowski cited by the Examiner on column 13, lines 14-42, details either immediately after scanning the coupon or after a coupon has been stored in RAM means 23 the user selects particular coupons to "segregate" them to a "shopping list". More specifically, Fajkowski discloses at column 13, lines 15-17, "This routine will allow the user to segregate coupons for specific products that the user desires to purchase during a future shopping trip." Therefore, it is the "user" that segregates the coupons to a "shopping list" and not, a computer implemented method of, "outputting a suggestion to said user, by said computer, displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons," per Appellant's claimed invention.

C. Appellant submits, that Fajkowski fails to teach or suggest, "choosing one of saved sets of e-coupons based on comparing two or more of said saved sets of e-coupons," according to Appellant's independent claims 1 and 15, and similarly, "comparing by a user two or more saved sets of e-coupons and choosing one of saved sets of e-coupons," according to Appellant's independent claims 22 and 49.

The Examiner in this rejection beginning on page 20 of the Non-Final Office Action with respect to independent claims, 1, 15, 22, 49 and 62, fails to address any of Appellant's claimed limitations with respect to Fajkowski.

Appellant, assuming *arguendo*, that the Examiner maintains the rejection of Fajkowski from the previous rejections, the Examiner alleges Fajkowski disclosing the issuance of a "rain-check" is equivalent to Appellant's claimed, "another sub-set of said e-

coupons.” Fajkowski discloses that, “[w]hen a customer has on his coupon card a coupon for an item which is out of stock and the coupon is about to expire, the store may place a marker on the coupon indicating it has been made available for rainchecking.”

However, using the Examiner's logic of equating the elements of Fajkowski with Appellant's claimed invention, nowhere in Fajkowski, nor in any other cited art of record is there any teaching or suggestion that demonstrates choosing either the “shopping list” of user-segregated coupons OR the rainchecked marked coupons based on comparing the user-segregated coupons and the rainchecked marked coupons, per Appellant's claimed invention. The user-segregated coupons are used after the user has purchased the items per Fajkowski's disclosure at column 17, and the raincheck marked coupons are used to merely allow a customer to “utilize the coupon after its expiration date,” from column 20, lines 39-47. There is no comparison between either of these “lists,” since each “list” is disclosed as being used independently of the other. Though the “raincheck” marked coupons are generated from the predetermined user-segregated coupon “shopping list” upon the determination of one or more item's unavailability at the time of sale, neither list is compared to the other for the purposes of choosing to use one list over other the other in a checkout POS transaction.

D. Appellant submits, that Fajkowski fails to teach or suggest, “recommending to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons,” according to Appellant's independent claims 1, 15, 22 and 49, and similarly, “wherein said user interface communicates a recommendation to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons,” according to Appellant's independent claim 62.

The Examiner in this rejection beginning on page 20 of the Non-Final Office Action with respect to independent claims, 1, 15, 22, 49 and 62, fails to address any of Appellant's

claimed limitations with respect to Fajkowski.

Appellant, assuming *arguendo*, that the Examiner maintains the rejection of Fajkowski from the previous rejections, the Examiner alleges that Fajkowski disclose Appellant's claimed invention in that, "Fajkowski's system is also quite intelligent in that it can recommend an additional purchase when a consumer possesses a valuable coupon, but has not fully met the purchasing qualifications (perhaps the user chose the wrong size product) [19:38-43]." However, Appellant's claimed invention claims, "recommending to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons," NOT recommending an additional purchase in relation to the customer's existing purchase, and certainly not based on choosing either the user-segregated coupon "shopping list" or the "raincheck" marked coupons, as argued above in section C.

The Examiner in this rejection beginning on page 20 of the Non-Final Office Action with respect to independent claims, 1, 15, 22, 49 and 62, fails to address any of Appellant's claimed limitations with respect to Fajkowski.

Appellant, assuming *arguendo*, that the Examiner maintains the rejection of Fajkowski from the previous rejections, the Examiner alleges Fajkowski discloses, "[r]egarding the saved coupons, the choosing among them and recommending based on the saved coupons, Fajkowski teaches that the user may save shopping lists with specified coupons for the products on the list to be used on future shopping trips [13:14- 41]. Fajkowski also teaches the idea of issuing a rain check for a coupon item the user wishes to purchase, but where the item is currently unavailable. The system will save such a list of rain-checked product(s) for later use. In either case, future use of the saved lists are taken to meet the broad "comparing" by a user. Further, the art describes the capability to save any number

of coupons which enables saving combinations of coupons.” However, as argued in the above paragraph, nowhere does Fajkowski teach or suggest recommending to a user to use *an additional e-coupon* in relation to user’s purchase, or recommending based on choosing either the user-segregated coupon “shopping list” or the “raincheck” marked coupons, as argued above in section C.

Appellant, assuming *arguendo*, that the Examiner maintains the rejection of Fajkowski from the previous rejections, the Examiner alleges Fajkowski discloses, “[i]t would have been obvious to one of ordinary skill at the time of the invention for the system's coupon(s) recommendations to have included coupons that had been "saved". Further still, Fajkowski's also teaches that the system can recommend an additional purchase when a consumer possesses a valuable coupon, but has not fully met the purchasing qualifications (perhaps the user chose the wrong size product) [19:38-43].” Again, per Appellant's argument in the above paragraphs, Appellant's claimed invention claims, “recommending to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons,” NOT recommending an additional purchase in relation to the customer's existing purchase, and certainly not based on choosing either the user-segregated coupon “shopping list” or the “raincheck” marked coupons, as argued above in section C.

Therefore, the Examiner's allegations of motivation to modify Fajkowski with the level skill of one of ordinary skill in the art, *i.e.*, “[i]t would have been obvious to one of ordinary skill at the time of the invention to have recommended the use of saved coupon where the user is close to an optimized coupon eligibility, but needs to make slight changes to his products for purchase;” and that “[i]t would have been obvious to one of ordinary skill at the time of the invention to have recommended this additional coupon even if this is a

coupon that had been previously saved,” is erroneous since nowhere in the disclosure of Fajkowski, and nowhere has the Examiner provided the requisite evidence of the level of one of ordinary skill in the art to “recommend to a user to use an additional e-coupon in relation to a purchase based on choosing saved sets of e-coupons.”

In summary, Fajkowski is directed toward the creation of a user-segregated coupon “shopping list” for presentation to a POS terminal after purchase, and a “raincheck” marked list of coupons that allows a customer to utilize a coupon after its expiration date. Whereas, Appellant’s claimed invention is directed toward recommending to a user to use an additional e-coupon in relation to a purchase based on choosing one particular saved set of e-coupons.

E. The Examiner on page 20 of the Non-Final Office Action state with respect to the combination of Marmon with Fajkowski:

Marmon teaches that shopping can get quite complicated when pricing systems are combined with cents off coupons and retailers offer to double or triple coupons [col 1 lines 38-42]. Fajkowski provides a calculating tool for optimizing purchasing decisions affected by the complex pricing combinations that include coupons [col 1 lines 50-60]. Marmon notes that the consumer is confronted with many price-affecting choices related to coupons and that he usually is seeking low prices [col 2 lines 53-57]. Understanding the choice of optimum purchase requires an understanding of coupon procedures (i.e. rules) and unit pricing techniques [col 3 lines 20-22]. The calculations done by the system of Fajkowski consider the impact of the coupon and the optimum choice, i.e. lowest until price is indicated to the user [col 3 lines 51-53].

Appellant fails to understand what elements of Appellant's claimed invention Fajkowski fails to teach or suggest that necessitate a combination with the Marmon reference. Alternatively stated, Applicant maintains that this rejection over the combination of Wajkowski and Marmon is NOT proper since the Examiner fails to identify what elements of Appellant's claimed invention are NOT taught by Fajkowski and which elements of Marmon teach those missing elements and why one of ordinary skill in the art would have combined the references based on either teaching within the references or the demonstration with

evidence of the level of one of ordinary skill in the art.

E. The Examiner in this rejection beginning on page 20 of the Non-Final Office Action with respect to independent claims, 1, 15, 22, 49 and 62, fails to address any of Appellant's claimed limitations with respect to Wilkman.

Appellant, assuming *arguendo*, that the Examiner maintains the rejection from Fajkowski in view of Wilkman rejection above in section 3., the Examiner states on page 16 of the Non-Final Office Action:

Wilkman also recognizes the variety of incentive offers available to purchasing consumers and he teaches the use of a computer-based optimization routine that takes the legwork out of manually analyzing the variety of eligible combinations and benefits (price, coupons, promotions, loyalty, etc.) in order to provide the best benefit for the consumer [abstract]. It would have been obvious to one of ordinary skill at the time of the invention to have provided systems and methods that provide assistance to customers faced with navigating the recognized (albeit in some cases difficult or confusing) coupon rules and options imposed by the incentive providers. Rather than take the time and energy to manually track all of the provided options, restrictions and benefits, It would have been obvious to one of ordinary skill at the time of the invention to have provided a computer system to optimize the 'non trivial' combination of coupon restrictions and benefits, so that the consumer need not be burdened with the research (although it is well accepted that in the past the research has been capably done manually).

Appellant fails to understand what elements of Appellant's claimed invention Fajkowski fails to teach or suggest that necessitate a combination with the Wilkman reference. Alternatively stated, Applicant maintains that this rejection over the combination of Wajkowski and Wilkman is NOT proper since the Examiner fails to identify what elements of Appellant's claimed invention are NOT taught by Fajkowski and which elements of Wilkman teach those missing elements and why one of ordinary skill in the art would have combined the references based on either teaching within the references or the demonstration with evidence of the level of one of ordinary skill in the art.

Therefore, Appellant respectfully requests the Board to reconsider and withdraw this

rejection since the alleged prior art references to Fajkowski, Wilkman and Marmon (either alone or in combination) fail to teach or suggest each element and feature of Appellant's claimed invention.

CONCLUSION

In view of the foregoing, Appellant submits that claims 1-2, 4-5, 7, 15-16, 18-19, 22-31, 33-35, 49-57, 59-62, 64, 66-67 and 69-70, all of the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. Thus, the Board is respectfully requested to remove the rejections of claims 1-2, 4-5, 7, 15-16, 18-19, 22-31, 33-35, 49-57, 59-62, 64, 66-67 and 69-70.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 09-0441.

Respectfully Submitted,

Date: April 6, 2010



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CLAIMS APPENDIX
[37 C.F.R. § 41.37 (c)(1)(viii)]

1. (Rejected) A computer-implemented method of making an optimized suggestion to a user regarding a combination of electronic coupons (e-coupons) for redemption by a retailer, said method comprising:

determining, by said computer, if a selection of e-coupons complies with redeeming conditions in relation to a purchase;

checking said selection of e-coupons complying with said redeeming conditions, by said computer, to determine mutually exclusive e-coupons of said selection of e-coupons applicable within said purchase, and to determine if two or more non-mutually exclusive e-coupons of said selection of e-coupons can be used in combination within said purchase;

defining optimization parameters by a user;

performing an optimization process, by said computer, on said selection of e-coupons to maximize a discount amount, a number of loyalty points, and a number of free items, by checking said selection of e-coupons complying with said redeeming conditions and capable of being used in combination within said purchase to determine if said selection of e-coupons satisfy said optimization parameters, said optimization process determining a most favorable combination of non-mutually exclusive e-coupons;

before said user makes said purchase, outputting a suggestion to said user, by said computer, displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons, said most favorable combination of non-mutually exclusive e-coupons comprising only said selection of e-coupons complying with said redeeming conditions and capable of being used in combination within said purchase;

saving said displayed most favorable combination of non-mutually exclusive e-coupons determined to comply with said redeeming conditions and capable of being used in combination within the same purchase and choosing another subset of said e-coupons;

choosing one of saved sets of e-coupons based on comparing two or more of said saved sets of e-coupons; and

recommending to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons.

2. (Rejected) The method according to claim 1, further including the step of selecting by a user said selection of e-coupons from a plurality of e-coupons.

3. (Canceled).

4. (Rejected) The method according to claim 1, further including the step of providing a recommendation to a user regarding an additional purchase enabling said user to avail of more discounts.

5. (Rejected) The method according to claim 1, wherein said checking of said selection of e-coupons comprises checking e-coupons that reside at any one of the group consisting of a user's site, a third party's site, and a site of said retailer in said networked environment.

6. (Canceled).

7. (Rejected) The method according to claim 1, wherein said networked environment is implemented utilizing one or more of the group consisting of the Internet, and Intranet, and Extranet, a local area network, an ATM network, a wide area network and a wireless network.

8-14. (Canceled).

15. (Rejected) A computer program product having a computer readable medium having a computer program recorded therein for making an optimized suggestion to a user regarding a combination of electronic coupons (e-coupons) for redemption by a retailer, said computer program product performing a method comprising:

determining if a selection of e-coupons complies with redeeming conditions in relation to a purchase;

checking said selection of e-coupons complying with said redeeming conditions to determine mutually exclusive e-coupons of said selection of e-coupons applicable within said purchase, and to determine if two or more non-mutually exclusive e-coupons of said selection of e-coupons can be used in combination within said purchase;

defining optimization parameters by a user;

performing an optimization process on said selection of e-coupons to maximize a discount amount, a number of loyalty points, and a number of free items, by checking said selection of e-coupons complying with said redeeming conditions and capable of being used in combination within said purchase to determine if said selection of e-coupons satisfy said optimization parameters, said optimization process determining a most favorable combination of non-mutually exclusive e-coupons;

before said user makes said purchase, outputting a suggestion to said user displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons, said most favorable combination of non-mutually exclusive e-coupons comprising only said selection of e-coupons complying with said redeeming conditions and capable of being used in combination within said purchase; saving said displayed most favorable combination of non-mutually exclusive e-coupons determined to comply with said redeeming conditions and capable of being used in combination within the same purchase and choosing another subset of said e-coupons; choosing one of saved sets of e-coupons based on comparing two or more of said saved sets of e-coupons; and recommending to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons.

16. (Rejected) The computer program product according to claim 15, further including selecting by a user said selection of e-coupons from a plurality of e-coupons.

17. (Canceled).

18. (Rejected) The computer program product according to claim 15, further including providing a recommendation to a user regarding an additional purchase enabling said user to avail of more discounts.

19. (Rejected) The computer program product according to claim 15, wherein said checking of said selection of e-coupons comprises checking e-coupons that reside at any one

of the group consisting of a user's site, a third party's site, and a site of said retailer in said networked environment.

20-21. (Canceled).

22. (Rejected) A computer-implemented method for electronic coupon (e-coupon) decision support, said method comprising:

computing, by said computer, a set of applicable e-coupons dependent upon a set of e-coupons of a user;

determining, by said computer, if said computed set of e-coupons complies with one or more redeeming conditions, which of said set of e-coupons are mutually exclusive within a same purchase and which of said set of e-coupons are non-mutually exclusive to be used in combination within the same purchase;

performing an optimization process, by said computer, on said selection of e-coupons to maximize a discount amount, a number of loyalty points, and a number of free items, by determining if said computed set of e-coupons determined to comply with said redeeming conditions and capable of being used in combination within the same purchase satisfy optimization parameters defined by said user, wherein said optimization parameters comprise at least one of a discount amount, loyalty points, a number of free items received, whether at least one particular e-coupon should be included, whether at least one particular e-coupon should not be included, expiration date, and a total number of e-coupons used, said optimization process determining a most favorable combination of non-mutually exclusive e-coupons;

before said user makes said purchase, outputting a suggestion to said user, by said

computer, displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons, said most favorable combination of non-mutually exclusive e-coupons comprising only said computed set of e-coupons determined to comply with said redeeming conditions and capable of being used in combination within the same purchase that satisfy said optimization parameters;

saving said displayed, computed set of e-coupons determined to comply with said redeeming conditions and capable of being used in combination within the same purchase and choosing another subset of said e-coupons;

comparing by a user two or more saved sets of e-coupons and choosing one of saved sets of e-coupons; and

recommending to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons.

23. (Rejected) The method according to claim 22, wherein said computing step is also dependent upon order information.

24. (Rejected) The method according to claim 22, further including the steps of, if said computed set of e-coupons contains at least one e-coupon failing to comply with said redeeming conditions:

displaying said computed set of e-coupons; and

enabling said user to select another set of e-coupons for use in said computing step.

25. (Rejected) The method according to claim 24, further including the step of: displaying exclusive e-coupons in said another selected set of e-coupons to said user.

26. (Rejected) The method according to claim 25, further including the step of: displaying e-coupons in said another selected set of e-coupon that are exclusive and fail to comply with said redeeming conditions to said user.

27. (Rejected) The method according to claim 22, further including the step of processing a purchase order for said displayed, computed set of e-coupons determined to comply with said redeeming conditions and capable of being used in combination within the same purchase.

28-29. (Canceled).

30. (Rejected) The method according to claim 22, further including the step of recommending to said user a set of e-coupons determined to comply with said redeeming conditions and capable of being used in combination within the same purchase.

31. (Rejected) The method according to claim 22, further including the step of a user viewing reports of e-coupon usage statistics and savings.

32. (Canceled).

33. (Rejected) The method according to claim 22, wherein said finding step is implemented using an optimization engine, said optimization engine addressing one or more conditions selected from the group consisting of:

an AND condition among product purchase redemption conditions;
an AND condition among category purchase redemption conditions;
an XOR condition among product purchase redemption conditions;
an XOR condition among category purchase redemption conditions; and
an e- coupon purchase condition on total amount and e-coupons with heterogeneous purchase conditions.

34. (Rejected) The method according to claim 22, further including the step of:
providing recommendations to said user, based on a profile of said user, in relation to
a user selected set of e-coupons.

35. (Rejected) The method according to claim 22, wherein said computing of said set of applicable e-coupons comprises computing e-coupons that reside at any one of the group consisting of a user's site, a third party's site, and a site of said retailer in said networked environment.

36-48. (Canceled).

49. (Rejected) A computer program product having a computer readable medium having a computer program recorded therein for electronic coupon (e-coupon) decision support, said computer program product including:
computing a set of applicable e-coupons dependent upon a set of e-coupons of a user;
determining if said computed set of e-coupons complies with one or more redeeming conditions, which of said set of e-coupons are mutually exclusive within a same purchase and

which of said set of e-coupons are non-mutually exclusive to be used in combination within the same purchase;

performing an optimization process on said selection of e-coupons to maximize a discount amount, a number of loyalty points, and a number of free items, by determining if said computed set of e-coupons determined to comply with said redeeming conditions and capable of being used in combination within the same purchase satisfy optimization parameters defined by said user, wherein said optimization parameters comprise at least one of a discount amount, loyalty points, a number of free items received, whether at least one particular e-coupon should be included, whether at least one particular e-coupon should not be included, expiration date, and a total number of e-coupons used, said optimization process determining a most favorable combination of non-mutually exclusive e-coupons;

before said user makes a purchase, outputting a suggestion to said user displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons, said most favorable combination of non-mutually exclusive e-coupons comprising only said computed set of e-coupons determined to comply with said redeeming conditions and capable of being used in combination within the same purchase that satisfy said optimization parameters;

saving said displayed, computed set of e-coupons determined to comply with said redeeming conditions and capable of being used in combination within the same purchase and choosing another subset of said e-coupons;

comparing by a user two or more saved sets of e-coupons;
choosing one of said saved sets of e-coupons; and
recommending to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons.

50. (Rejected) The computer program product according to claim 49, wherein said computing is also dependent upon order information.

51. (Rejected) The computer program product according to claim 49, further including, if said computed set of e-coupons contains at least one e-coupon failing to comply with said redeeming conditions:

displaying said computed set of e-coupons; and
enabling said user to select another set of e-coupons for use in said computing step.

52. (Rejected) The computer program product according to claim 51, further including displaying exclusive e-coupons in said another selected set of e-coupons to said user.

53. (Rejected) The computer program product according to claim 52, further including displaying e-coupons in said another selected set of e-coupons that are exclusive and fail to comply with said redeeming conditions to said user.

54. (Rejected) The computer program product according to claim 49, further including processing a purchase order for said displayed, computed set of e-coupons determined to comply with said redeeming conditions and capable of being used in combination within the same purchase.

55-56. (Canceled).

57. (Rejected) The computer program product according to claim 49, further including recommending to said user a set of e-coupons determined to comply with said redeeming conditions and capable of being used in combination within the same purchase.

58. (Canceled).

59. (Rejected) The computer program product according to claim 49, wherein said finding is implemented using an optimization engine, said optimization engine addressing one or more conditions selected from the group consisting of:

- an AND condition among product purchase redemption conditions;
- an AND condition among category purchase redemption conditions;
- an XOR condition among product purchase redemption conditions;
- an XOR condition among category purchase redemption conditions; and
- an e-coupon purchase condition on total amount and e-coupons with heterogeneous purchase conditions.

60. (Rejected) The computer program product according to claim 49, further including:

- providing recommendations to said user, based on said user's profile, in relation to a user selected set of e-coupons.

61. (Rejected) The computer program product according to claim 49, wherein said computing of said set of applicable e-coupons comprises computing e-coupons that reside at

any one of the group consisting of a user's site, a third party's site, and a site of said retailer in said networked environment.

62. (Rejected) An electronic coupon (e-coupon) decision support system for making an optimized suggestion to a user regarding a combination of electronic coupons (e-coupons) for redemption by a retailer, said system including:

a hardware module adapted to:

compute a set of applicable e-coupons dependent upon a set of e-coupons of a user;

determine if said computed set of e-coupons complies with one or more redeeming conditions, which of said set of e-coupons are mutually exclusive within a same purchase and which of said set of e-coupons are non-mutually exclusive to be used in combination within the same purchase; and

display only said computed set of e-coupons determined to comply with said redeeming conditions and capable of being used in combination within the same purchase;

an optimization engine adapted to perform an optimization process on said selection of e-coupons to maximize a discount amount, a number of loyalty points, and a number of free items, by determining a subset of e-coupons from said computed set of e-coupons determined to comply with said redeeming conditions and capable of being used in combination within the same purchase, to determine a most favorable combination of non-mutually exclusive e-coupons; and

a user interface adapted to output a suggestion to said user displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons, said most favorable combination of non-mutually exclusive e-coupons before said user makes said purchase;

a storage device adapted to save said displayed most favorable combination of non-mutually exclusive e-coupons determined to comply with said redeeming conditions and capable of being used in combination within the same purchase and choosing another subset of said e-coupons, wherein one of saved sets of e-coupons is chosen based on comparing two or more of said saved sets of e-coupons,

wherein said user interface communicates a recommendation to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons.

63. (Canceled).

64. (Rejected) The system according to claim 62, further including:
a recommendation engine for providing recommendations regarding one or more further purchases to a user, based on said user's profile, after said user has selected a set of e-coupons to use.

65. (Canceled).

66. (Rejected) The system according to claim 62, wherein said hardware module, said software module, and said optimization engine are adapted to analyze e-coupons that are located at a retailer's site, a user's site, or a third party site in a network.

67. (Rejected) The method according to claim 1, wherein said optimization process is limited by parameters comprising which e-coupons should be included, an

expiration date of said e-coupons, and a total number of e-coupons used.

68. (Canceled).

69. (Rejected) The computer program product according to claim 15 wherein said optimization process is limited by parameters comprising which e-coupons should be included, an expiration date of said e-coupons, and a total number of e-coupons used.

70. (Rejected) The system according to claim 62, wherein said optimization engine is limited by parameters comprising which e-coupons should be included, an expiration date of said e-coupons, and a total number of e-coupons used.

71-73. (Canceled).

EVIDENCE APPENDIX
[37 C.F.R. § 41.37 (c)(1)(ix)]

Not applicable.

RELATED PROCEEDINGS APPENDIX

[37 C.F.R. § 41.37 (c)(1)(x)]

Not applicable.